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10/539,284

06/16/2005

Harald Jakob

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05/07/2007

LAW OFFICE OF MICHAEL A. SANZO, LLC
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EXAMINER

DELCOTTO, GREGORY R

ART UNIT

PAPER NUMBER

1751

MAIL DATE

DELIVERY MODE

05/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,284

Applicant(s)

JAKOB ET AL.

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) 32-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-31 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 19-37 are pending. Claims 1-18, 38, and 39 have been canceled.

Applicant's amendments and arguments filed 12/1/06 have been entered.

Applicant's election of Group I, claims 19-31 and 37 in the reply filed on 12/1/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 32-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/1/06. Note that, claims 37 and 38 have been canceled.

Objections/Rejections Withdrawn

The following objections/rejections set forth in the Office action mailed 8/18/06 have been withdrawn:

The rejection of claims 19-23, 26-31, and 37 under 35 USC 103(a) as being unpatentable over Bertsch-Frank et al (US 5,902,862) alone or further in view of EP 623553 has been withdrawn.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19-23, 26, and 28-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bertsch-Frank et al (US 5,902,682).

Bertsch-Frank et al are relied upon as set forth in the Office action mailed 8/18/06. Further, the Examiner asserts that the coated bleach particles as taught by Bertsch-Frank et al would inherently have the same properties as the compositions recited by the instant claims because Bertsch-Frank et al teach compositions containing the same components in the same amounts as recited by the instant claims wherein the

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particles are made by spraying an aqueous solution of the coating agent onto the bleach particles. Bertsch-Frank et al disclose the claimed invention with sufficient specificity to constitute anticipation. Note that, the Examiner asserts that claim 19 is a product by process claim due to the limitation "wherein said outer layer has been prepared using an aqueous solution comprising 2 to 20 wt% alkali metal silicate" and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing to be substantially identical is found a 35 USC 102/103 rejection is made, the burden shifts to the applicant to show an unobvious result. See MPEP 2113.

Accordingly, the teachings of Bertsch-Frank et al anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Bertsch-Frank et al are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed delayed release properties of the composition in order to provide the optimum bleaching and cleaning properties to the composition because Bertsch-Frank et al teach that the amounts and types of required components added to the composition may be varied.

Claims 19-26 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 2,326,560 in view of Bertsch-Frank et al (US 5,902,682).

'560 teaches mono- or multilayer coated particulate peroxo compounds having a core of one or more peroxo compounds having a core of one or more peroxo compounds and a coating of predominantly inorganic compounds, wherein the core or the coating comprises one or more dyes. See Abstract. A particularly preferred peroxo compound is sodium percarbonate. See page 5, lines 5-15. The coating materials may be chosen from an inorganic substances which are suitable to be applied to the particulate peroxo compounds and have a stabilizing action on the peroxo compounds. Examples of coating materials are alkali metal salts such as sodium carbonates, sulfates, alkali metal silicates, etc. Specific examples of coating materials include sodium carbonate with sodium sulfate, etc. The coating is usually applied in an amount of from 0.5 to 20% by weight, based on the peroxo compound. See page 5, line 30 to page 6, line 20. To prepare the particulate peroxo compounds coated according to the invention in a fluidized bed, the particles to be coated which are in the fluidized bed are sprayed with the coating material while maintaining a fluidized-bed temperature of from 30 to 100 degrees Celsius. If two or more layer are applied, then the aqueous solutions or dispersions of the coated materials are sprayed on successively. Note that, the Examiner asserts that spraying an aqueous solution of a coating material such as sodium silicate as taught by '560 is the same as using an aqueous solution of sodium silicate for the outer coating layer as recited by the instant claims. Additionally, the Examiner asserts that claim 19 is a product by process claims and even though

product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing to be substantially identical is found a rejection is made, the burden shifts to the applicant to show an unobvious result. See MPEP 2113.

For use in detergents and cleaners, preference is given to using particulate peroxo compounds which have a spherical shape and a diameter of from 0.8 μ m to 3.0 μ m. See page 8, lines 1-25.

'560 does not teach alkali metal silicates used for coating having the same modulus ratio as recited by the instant claims or a coated peroxygen compound having an inner coating containing a hydrate-forming inorganic salt, an outer coating containing an alkali silicate having a specific modulus, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Bertsch-Frank et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use an alkali metal silicate having the specific modulus as recited by the instant claims in the coating taught by '560, with a reasonable expectation of success, because Bertsch-Frank et al teach the use of alkali metal silicates having the specific modulus as recited by the instant claims as coating material in a similar

peroxygen bleach coated particle and further, '560 teaches the use of alkali metal silicates as coating materials in general.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a coated peroxygen compound having an inner coating containing a hydrate-forming inorganic salt, an outer coating containing an alkali silicate having a specific modulus, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '560 in combination with Bertsch-Frank et al suggest a coated peroxygen compound having an inner coating containing a hydrate-forming inorganic salt, an outer coating containing an alkali silicate having a specific modulus, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertsch-Frank et al (US 5,902,682) as applied to claims 19-23, 26, and 28-31 above, and further in view of CA 2,326,560.

Bertsch-Frank et al are relied upon as set forth above. However, Bertsch-Frank et al do not teach the use of sodium sulfate as a coating agent in addition to the other requisite components of the composition as recited by instant claims 24 and 25.

'560 is relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use sodium sulfate as a coating agent in the composition taught by Bertsch-Frank et al, with a reasonable expectation of success, because '560 teaches

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the equivalence of sodium sulfate to sodium carbonate as a coating agent in a similar bleach coated particle and further, Bertsch-Frank et al teach the use of sodium carbonate as a coating material in general.

Claims 27 and 37 rejected under 35 U.S.C. 103(a) as being unpatentable over Bertsch-Frank et al (US 5,902,682) or CA 2,326,560 in view of Bertsch-Frank et al (US 5,902,682) as applied the rejected claims above, and further in view of Bailley et al (US 6,017,867).

Bertsch-Frank et al and CA 2,326,560 are relied upon as set forth above. However, neither reference teaches the use of an auxiliary substance such as silica in addition to the other requisite components of the composition as recited by instant claims 27 and 37.

Bailley et al teach a granular detergent composition comprising an alkali metal percarbonate, characterized in that percarbonate has a mean particle size of from 250 to 900 micrometers, and that said compositions comprise a hydrophobic material, selected from silica, talc, zeolite DAY, etc. See Abstract. This hydrophobic material such as silica, when used as a dusting agent onto said percarbonate particles prior to their incorporation into the composition, provides the storage stability of the percarbonate in all types of compositions. See column 1, lines 40-60.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a material such as silica as an outermost coating on the coated percarbonate particles taught by Bertsch-Frank or '560, with a reasonable expectation of success, because Bailley et al teach the advantageous storage stability

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properties provided to a similar coated percarbonate particle when using silica as an outer coating.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-31 and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 11/301330 and claims 16-25, 30, and 31 of 10/539285. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-13 of 11/301330 and claims 16-25, 30, and 31 of 10/539285 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a coated peroxygen compound having an inner

coating containing a hydrate-forming inorganic salt, an outer coating containing an alkali silicate having a specific modulus, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success, because claims 1-13 of 11/301330 and claims 16-25, 30, and 31 of 10/539285 suggest a coated peroxygen compound having an inner coating containing a hydrate-forming inorganic salt, an outer coating containing an alkali silicate having a specific modulus, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

With respect to Bertsch-Frank et al, Applicant states that the Examiner has failed to appreciate the full significance of the concentration of the aqueous solution of alkali metal silicate used to coat the outer layer of the bleach as recited by the instant claims. Furthermore, Applicant states that comparative data has been presented in the instant specification in Examples 1 to 3 which shows that the release of active oxygen from the core of coated tablets depends upon the concentration of alkali metal silicate in the solutions used to make the outer coating. In response, note that, as set forth above, claim 19 is a product by process claim and Applicant has provided no data or evidence showing that the composition as taught by Bertsch-Frank et al does not inherently have the same properties the composition recited by the instant claims. Thus, the Examiner maintains that Bertsch-Frank et al is sufficient to anticipate the instant claims under 35

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USC 102 and secondary considerations are not sufficient to overcome a rejection under 35 USC 102.

Alternatively, even if Bertsch-Frank et al was not sufficient to anticipate the instant claims under 35 USC 102, which the Examiner is clearly not conceding, the Examiner asserts that the data is not sufficient to show the unexpected and superior properties of the claimed invention over compositions falling outside the scope of the instant claims. First, note that Bertsch-Frank does teach coating the bleach particles using aqueous solutions of alkali metal silicate and Applicant has provided no comparison to the closest prior art; the Examiner asserts that one of ordinary skill in the art would reasonably expect the coated bleach activators of Bertsch-Frank et al to have the same dissolution properties as the particles recited in the instant claims because the particles taught by Bertsch-Frank et al are made the same way and contain the same components as the particles recited by the instant claims. Additionally, the data presented in Examples show only compositions which are made within the scope of the claimed invention and does not show the unexpected and superior properties of the claimed invention in comparison to compositions falling outside the scope of the instant claims. Examples 1-3 all show coating using alkali metal silicate solutions having a concentration of silicate falling within the scope of the instant claims and do not show a comparison to solutions having an alkali metal silicate concentration outside the scope of the instant claims.


Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less than any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory R. Del Cotto
Primary Examiner
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April 30, 2007